

TRANSMITTAL OF APPEAL BRIEF (Small Entity)Docket No.
6802-82887In Re Application Of: **Donald Gale**

Serial No.

09/867,207

Filing Date

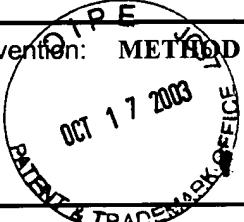
05/29/2001

Examiner

J. Young

Group Art Unit

3622

Invention: **METHOD OF MANAGING A REAL ESTATE UNIT****TO THE COMMISSIONER FOR PATENTS:**

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
August 25, 2003

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- is enclosed.
- has already been filed in this application.

The fee for filing this Appeal Brief is: **\$165.00**

- A check in the amount of the fee is enclosed.
- The Director has already been authorized to charge fees in this application to a Deposit Account.
- The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 23-0920

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GROUP 3600*Signature*Dated: October 13, 2003

Jon P. Christensen
Reg. No. 34,137

I certify that this document and fee is being deposited on October 3, 2003 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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10-29-23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gale, Donald

Art Unit: 3622

Serial No.: 09/867,207

Filed: May 29, 2001

For: METHOD OF MANAGING
A REAL ESTATE UNIT

Examiner: Young, J.

Attorney
Docket No.: 82887

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GROUP '3600

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Final rejection of February 26, 2003 and Advisory Action of September 3, 2003 and in support of the applicant's Notice of Appeal filed August 25, 2003, the applicant appeals as follows:

I. Real Party in Interest.

The real party in interest is Rental Tracker, by assignment dated January 29, 1999 and recorded at Reel/Frame 9765/0405.

II. Related Appeals and Interference.

None.

III. Status of Claims.

Claims 25-48 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 5,680,305 to Apgar IV in view of U.S. Pat. No. 5,584,025 to Keithley, in view of U.S. Pat. No. 6,049,781 to Forrest et al., in view of U.S. Pat. No. 5,893,091 to Hunt et al., in view of U.S. Pat. No. 6,157,943 to Meyer. The finality of the Office Action of 2/26/03 was withdrawn in an Advisory Action dated 9/3/03.

IV. Status of Amendments.

The claims have not been amended since the final Office Action of February 26, 2003.

V. Summary of Invention.

The invention is drawn to a method and apparatus of managing a real estate unit from a remote location. To facilitate management of the real estate unit, a website 24 is provided within a central processing unit (CPU) 16 that receives information from one or more financial institutions (specification, page 5, lines 20-25). Alternatively, the CPU 16 may receive information from local

terminals 22, such as rental payments, receipt of invoices or tax information (specification, page 6, lines 1-7).

To access the website 24, the remotely located manager may enter an IP address of the website 24. The website 24 responds by downloading an HTML file that facilitates the return of data and commands to the server 10. Included within the downloaded HTML file may be one or more subroutines that allow the manager to access separate computer applications within the server 16 based upon a different code plug embedded within each subroutine (specification, page 6, line 32 to page 7, line 10).

Upon identification of the manager, "the server 16 passes the IP address and identifiers of the manager 12 to the server access application" that "grants access by the manager 12, but only to a predetermined set of files" (specification, page 8, lines 5-12). Further, "the access application may grant access by transferring the IP address of the manager 12 and an access spec to a user service module of the secure server 16 . . . The access spec may be an access file containing a property identifier and list of files to which the manager is entitled access" (specification, page 9, lines 9-22).

Upon gaining access to the user service module, the manager may be allowed to perform any of a number of managerial functions. For example, a "first selection '1 Inquiry' may be used to allow the manager to obtain detailed information for the selected unit . . . the second selection '2 Billing & Cash Entries'

allows the manager to monitor the selected unit's cash position . . .
. "The third selection '3 File Maintenance' allows the manager to modify data upon which the data of previous screens were based . . .
The fourth selection '4 Reports' allows the manager to view any of a number of financial and regulatory reports . . . The fifth selection '5 System' allows the manager 12 to perform system functions . . .
The last selection '[6] System' allows the manager to exit the managerial functions" (specification, page 10, line 31 to page 11, line 17).

VI. Issues.

Whether an Examiner may pick and choose from among diverse elements of the prior art to render obvious a claimed invention absent a recognition of the problem solved by the claimed invention.

VII. Grouping of Claims.

It is believed that the rejection of claims 25-48 is based upon the same common error. It is therefore requested that the claims be grouped together for the limited purpose of this appeal.

VIII. Argument.

A. Claim 1, upon which claims 2-34 rely, is drawn to "providing a website for use by the real estate manager in managing the real estate unit . . . downloading a webpage to the real estate manager containing a set of options . . . selecting at least one of the options . . . uploading . . . the selected option from the remote location to the server; and executing the computer program associated with the selected option within the server". Claim 35, upon which claims 36-44 rely, and claim 45, upon which claims 46-48 rely, contain structural limitations drawn to similar subject matter. In order for a remotely located manager to manage a real estate unit from a remote location, a website would necessarily have to be combined with the information processing capabilities of a central processing unit in a manner that is transparent to the capabilities of either technology. It is believed that Apgar, Keithley, Forrest et al., Hunt et al. and Meyer, taken together or individually, fail to teach or suggest the unique combination of elements of the claimed invention. Further, it is believed that the sheer number of patents cited by the Examiner is, in itself, evidence of the nonobviousness of the claimed invention.

For example, Apgar is explicitly directed to a method of evaluating real estate, not to managing a real estate unit (see pages 2-3 of Response filed on 11/29/00 in parent application number 09/244,960). Further, the output of Apgar is completely different

than that of the claimed invention. For example, under Apgar "the invention provides useful information assessments to Customers as the Business Entity's business mix changes, such as when (1) competition focuses business managers' attention on cost reduction and growth-including occupancy and location; (2) re-engineering challenges assumptions including changes in real estate types (office, industrial, retail) and building grades; (3) technology improvements increase the potential for alternative locations and building types; and (4) changes in capital markets structure lead to reevaluation of real estate investments, including interest rates, real estate supply and demand, and investment rates of return" (Apgar, col. 4, lines 13-23).

The evaluation of real estate in Apgar may be converted into a score. The score "is then communicated to a Customer of the invention by way of the display 20, printer 22, and/or telephone and/or facsimile and/or modem device" (Apgar, col. 6, lines 40-45).

In contrast, a person of skill in the art would understand the output of "managing of the real estate units" to be, *inter alia*, a contract for rental or sale of a unit, such services as repair, upkeep and cleaning, rental receipts or payments made for the real estate unit's financial obligations (e.g., mortgage, taxes, assessments" (Specification, page 5, lines 1-12). Since Apgar merely provides information, it cannot, in any real sense, control or direct a real estate unit (pages 3-4, Response of 11/29/00).

In the Office Action of 12/14/00 (page 18, parent application 09/244,960), the Examiner asserts that "evaluation of real estate in the context of Apgar's disclosure suggests management of real estate, notwithstanding Webster's definitions".

However, what the Examiner fails to understand is that while evaluation may be a tool used by a manager, it does not suggest any mechanism that would allow a manager to manage from a remote location.

Similarly, Keithley is merely directed to a server for tracking and viewing data. Keithley contains no mention of the Internet or of websites (page 7, Response of 11/29/00).

Forrest et al. is directed to a relocation tracking system and method that uses a local area network (LAN). However, a LAN, by definition is a short distance data communications network. A private network, by definition, is not part of the Internet (page 8, Response of 11/29/00).

Further, even if a LAN were to be connected to the Internet, a firewall would be required for security to preserve the private nature of the LAN. As such, a server running on a LAN would not be readily accessible through the Internet.

The Examiner asserts with regard to Forrest that "Forrest (col. 5, ll. 10-24; col. 2, ll. 55-67; FIG. 1; and FIG. 13) proposes website modifications that would have applied to the method of Apgar" (Office Action of 9/3/03, pages 3-4). However, Forrest et al. does not provide any teaching, whatsoever, regarding the

Internet or of the use of websites.

Hunt et al. is directed to an Internet multicast system for sending real estate advertisements to an end user. As such, Hunt et al. has no relevance to the control of a real estate unit by a remotely located manager (page 10, Response of 12/5/02).

Meyer is directed to a web site for a facilities management system. However, instead of managing a real estate unit, Meyer explicitly states that "The present invention relates to controlling systems of a building, such as those which provide heating, ventilation, air conditioning, fire detection, and building access and security" (Meyer, col. 1, lines 6-10).

As would be clear to one of ordinary skill in the art, the management of a real estate unit (as under the claimed invention) would be understood to involve the business of the real estate unit. It would not be directed to controlling the systems of the real estate unit because it would be understood that a user (e.g., a tenant) would control the systems of the real estate unit.

B. A Prima facie Case of Obviousness Has Not Been Established

The Federal Circuit has continually held that the Examiner has the burden under 35 U.S.C. §103 of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 5 USPQ2d

1596 (Fed. Cir. 1988). This burden may be satisfied only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to the claimed invention. For example, as the Federal Circuit has held recently, as well as on numerous other occasions: "[t]here must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, supra, 24 USPQ2d at 1446.

Moreover, the mere fact that the prior art references could be modified in the manner proposed by the Examiner would not have made the modification obvious unless there is some motivation or suggestion in the prior art to do so. In re Gordon, 773 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), also see In re Fritch, 972 F.2d 1260, 23 USPQ2d 1781, 1783 (Fed. Cir. 1992) (The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification).

When making an assessment of the obviousness of the claimed invention, the prior art, viewed as a whole, must "suggest the desirability, and thus the obviousness, of making the combination." In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992), quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). Similarly, the Examiner, under §103, must consider the

claimed subject matter "as a whole". In assessing the claimed subject matter "as a whole", the results and advantages of the claimed invention must be considered. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 143 (Fed. Cir. 1987).

It is incumbent upon the Examiner to demonstrate that the proposed combination of reference teachings is proper. Where no express teaching or suggestion is apparent from the references, the Examiner must establish, with evidence or reasoning, why one skilled in the art would have been led by the relevant teachings of the applied references to make the proposed combination. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). When making an obviousness rejection, "[i]t is impermissible, however, simply to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template". In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Applicant submits, upon a close examination of the record, that the Examiner has failed to meet the burden of establishing a prima facie case of obviousness. In general, the Examiner has failed to establish, with evidence or reasoning, why one skilled in the art would have been led by the relevant teachings of the applied references to make the proposed combination. Further, the Examiner has apparently engaged in

hindsight reconstruction as demonstrated by his assertion that "Apgar . . . shows elements that suggest 'managing a real estate unit from a remote location, such method comprising the steps of: accessing a server from a remote location . . . downloading . . . a set of options regarding the managing of the real estate unit . . . to the remote location; selecting at least one of the options . . . uploading the . . . selected option from the remote location to the server; and executing the computer program associated with the selected option with the selected option within the server" (Office Action of 9/3/03, pages 3-4); when, in fact, it is only the specification that teaches these steps in a manner that could be understood and put to a practical use.

Further, the fact that the Examiner relies upon the above "simplified" version of the claims and disparate elements from unrelated patents such as Keithley, Forrest et al., Hunt et al. and Meyer demonstrates that the Examiner has failed to consider the claimed subject matter "as a whole". The failure of the Examiner to consider the claimed subject matter "as a whole" is further demonstrated by the fact that none of the cited patents of the combination of Agar, Keithley, Forrest et al., Hunt et al. and Meyer is directed to solving the precise problem solved by the claimed invention. Since none of the cited patents are directed to a method or apparatus that allows a remotely located manager to manage a real estate unit, there would be no reason to combine the references in the manner suggested by the Examiner.

For the foregoing reasons, reversal of the rejections of claims 25-48, as now presented, is believed to be in order and such action is earnestly solicited.

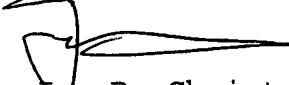
IX. CONCLUSION

For the foregoing reasons, allowance of claims 25-48, as now presented, is believed to be in order. It is respectfully requested that this Board reverse the decision of the Examiner in all respects.

Respectfully submitted,

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By


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Appendix of Claims

25. A method of managing a real estate unit by a real estate manager from a remote location, such method comprising the steps of:

providing a website for use by the real estate manager in managing the real estate unit;

accessing a server by the real estate manager from a remote location through the website of the server provided for use by the real estate manager;

downloading a webpage to the real estate manager containing a set of options regarding the managing of the real estate unit from the website to the real estate manager at the remote location;

selecting at least one of the options by the real estate manager;

embedding a subroutine within the webpage activated by selection of the option by the manager that composes a message identifying a computer program within the server associated with the selected option;

uploading the composed message associated with the selected option from the remote location to the server; and

executing the computer program associated with the selected option within the server.

26. The method of managing the real estate unit as in claim 25 wherein the step of accessing the website further comprises transferring an identifier of a user to the server.

27. The method of managing the real estate unit as in claim 26 wherein the step of transmitting the identifier further comprises comparing the identifier with an identifier of an authorized user and granting access to a set of files when a match is found.

28. The method of managing the real estate unit as in claim 27 further comprising uploading monetary data regarding this real estate unit from a designated financial institution to the server.

29. The method of managing the real estate unit as in claim 28 wherein the step of uploading the monetary data further comprises storing the monetary data in the set of files.

30. The method of managing the real estate unit as in claim 25 wherein the step of downloading a set of options further comprises providing a plurality of real estate unit identifiers as options of the set of options.

31. The method of managing the real estate unit as in claim 25 wherein the step of downloading a set of options further comprises providing a billing and cash entries selection for a real estate unit as an option of the set of options.

32. The method of managing the real estate unit as in claim 25 wherein the step of downloading a set of options further comprises providing a reports selections as an option of the set of options.

33. The method of managing the real estate unit as in claim 25 wherein the step of downloading a set of options further comprises providing a utilities selection as an option of the set of options.

34. The method of managing the real estate unit as in claim 25 wherein the step of downloading a set of options further comprises providing a system selection as an option of the set of options.

35. Apparatus for managing a real estate unit by a real estate manager from a remote location, such apparatus comprising:

a website provided for use by the real estate manager in managing the real estate unit;

means for accessing a server by the real estate manager from a remote location through the website of the server provided for use by the real estate manager;

means for downloading a webpage to the real estate manager containing a set of options regarding the managing of day-to-day operations directly related to use by an occupant of the real estate unit from the website to the remote location;

means for selecting by the real estate manager at least one of the options;

a subroutine activated by the means for selecting that composes a message identifying a computer program within the server associated with the selected option;

means for uploading composed message associated with the selected option from the remote location to the server; and

means for executing the identified computer programs associated with the selected option by the server.

36. The apparatus for managing the real estate unit as in claim 35 wherein the means for accessing the website further comprises means for transferring an identifier of a user to the server.

37. The apparatus for managing the real estate unit as in claim 36 wherein the means for transmitting the identifier further comprises means for comparing the identifier with an identifier of an authorized user and granting access to a set of files when a match is found.

38. The apparatus for managing the real estate unit as in claim 37 further comprising means for uploading monetary receipt data from a designated financial institution to the server.

39. The apparatus for managing the real estate unit as in claim 38 wherein the means for uploading the monetary receipt data further comprises means for storing the monetary receipt data in the set of files.

40. The apparatus for managing the real estate unit as in claim 35 wherein the means for downloading a set of options further comprises means for providing a plurality of real estate unit identifiers as an option of the set of options.

41. The apparatus for managing the real estate unit as in claim 35 wherein the means for downloading a set of options further comprises means for providing a billing and cash entries selection fro a real estate unit as an option of the set of options.

42. The apparatus for managing the real estate unit as in claim 35 wherein the means for downloading a set of options further comprises means for providing a reports selection as an option of the set of options.

43. The apparatus for managing the real estate unit as in claim 35 wherein the means for downloading a set of options further comprises means for providing a utilities selections as an option of the set of options.

44. The apparatus for managing the real estate unit as in claim 35 wherein the means for downloading a set of options further comprises means for providing a system selection as an option of the set of options.

45. Apparatus for managing a real estate unit by a real estate manager from a remote location, such apparatus comprising:

a website provided for use by the real estate manager in managing the real estate unit;

a remote processor used by the real estate manager to access a server from a remote location through the website of the server provided for the real estate manager;

a website used to download a webpage containing a set of options to the real estate manager regarding the managing of the real estate unit from the website to the remote location;

a cursor used by the real estate manager to select at least one of the options thereby providing a selected option of the set of options;

an applet within the remote processor used to upload an identifier of an application program associated with the selected option from the remote location to the server; and the applications program within the server used to execute the uploaded selected option.

46. The apparatus for managing the real estate unit as in claim 45 wherein the application program further comprises a comparator adapted to compare an identifier of an authorized user and granting access to a set of real estate unit files when a match is found.

47. The apparatus for managing the real estate unit as in claim 45 further comprising a modem adapted to upload monetary data regarding the real estate unit from a designated financial institution to the server.

48. The apparatus for managing the real estate unit as in claim 47 further comprising a memory adapted to store the monetary data.